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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/649,195	08/28/2000	Stephen J. Whitney	0112690-004	7963
29176	7590	05/19/2005	EXAMINER	
BELL, BOYD & LLOYD LLC			LAXTON, GARY L	
P. O. BOX 1135			ART UNIT	
CHICAGO, IL 60690-1135			PAPER NUMBER	

2838

DATE MAILED: 05/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/649,195

Applicant(s)

WHITNEY, STEPHEN J.

Examiner

Gary L. Laxton

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 February 2005.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10, 13, 15, 16, 20, 23, 24, 26 and 30 is/are rejected.
- 7) ☒ Claim(s) 11, 12, 14, 17-19, 21, 22, 25, 27-29 and 31-35 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 March 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments filed 02/07/05 have been fully considered but they are not persuasive.

The applicant argues that Wilken et al or Casey, do not disclose or suggest that part of the overvoltage protection device has a conductive portion and serves as one of the terminals. The examiner finds no difference with the claim language and the prior art references. If the overvoltage device is connected at the output then there is a direct connection between the overvoltage device and the output. Therefore it follows, that the device serves as a part of the output terminal. In other words, the output of the overvoltage device is the output of the protection circuit. Therefore, it serves as the output terminal inherently. The claim language used does not provide distinguishing features or novelty between the prior art and the applicant's invention.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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3. Claims 1 and 13 are rejected under 35 U.S.C. 102(e) as being anticipated by Wilken et al (US 6,178,080).

Wilken et al, figure 11, disclose an overcurrent protection portion (22); an overvoltage protection portion (42); and a plurality of terminals (Tip & Ring) for connecting both the overvoltage and overcurrent protection portions of the integral circuit protection device to the circuit to be protected (equipment), wherein a part of the overvoltage protection portion serves as one of the plurality of terminals (col. 7 lines 10-20: i.e. overvoltage protector 42 packaged to form an integrated device).

4. Claims 1-10, 13, 15, 16, 20, 23, 24, 26, and 30 are rejected under 35 U.S.C. 102(e) as being anticipated by Casey et al (US 6,407,901).

Claims 1, 3, 4, 9 and 10; disclose an overcurrent protection portion and an overvoltage protection portion (40, 41, 60, 80, 74, 94); and a plurality of terminals (Tip & Ring) for connecting both the overvoltage and overcurrent protection portions of the integral circuit protection device to the circuit to be protected (equipment), wherein a part of the overvoltage protection portion serves as one of the plurality of terminals (30 or 32)

Claims 2, 5 and 8; figures 1 and 2.

Claims 6 and 7; figure 1, thermally conductive portion 50, 51.

Claims 13, 15, 16, 23, 24, 26 and 30; figure 15, overcurrent device (60 & 80) between first terminal and second terminal, mounting member (figures 11 & 12), overvoltage device (60 & 80) connected to the second terminal and connected to a third terminal, terminal 30 or 32

serves as a part of the overvoltage voltage that is the third terminal. See for example figures 1 and 2.

Claim 20; the overcurrent is in series and the overvoltage is in parallel. See figures 1 and 2.

### ***Allowable Subject Matter***

5. Claims 11, 12, 14, 17-19, 21, 22, 25, 27-29 and 31-35 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

6. The following is a statement of reasons for the indication of allowable subject matter: the reasons for indicating allowable subject matter as the same as stated in the previous office action dated 2/13/04.

### ***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the


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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary L. Laxton whose telephone number is (571) 272-2079. The examiner can normally be reached on Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Sherry can be reached on (571) 272-2084. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

 5/16/05  
Gary L. Laxton  
Primary Examiner  
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